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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,947	10/05/2005	Tooru Yamakita	05670/LH	3610
1933	7590	12/17/2008	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			MISLEH, JUSTIN P	
			ART UNIT	PAPER NUMBER
			2622	
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			12/17/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/551,947	YAMAKITA, TOORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	JUSTIN P. MISLEH	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 August 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-5 and 10-12 is/are pending in the application.  
 4a) Of the above claim(s) 5 and 12 is/are withdrawn from consideration.  
 5) Claim(s) 10 is/are allowed.  
 6) Claim(s) 1,3,4 and 11 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 October 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed October 31, 2008 have been fully considered but they are not persuasive.

**With respect to amended Claim 1**

2. Applicant argues, “Lane et al does not disclose or suggest a writing device which determines whether or not writing of the image of the article captured by the image capture device into the electronic tag is permitted based on the electronic tag information read by the electronic tag reader, and which writes the image of the article captured by the image capture device into the electronic tag when it is determined that the writing of the image is permitted, as recited in amended independent claim 1.”

3. Applicant further states, “It is respectfully submitted, however, that Lane et al merely discloses that the controller 4A accesses the security circuit 4F ‘to authenticate the identity of the reader i0 and to determine if the reader i0 is authorized to request information from, or write information into, or otherwise direct the operation of the RFID tag 2’ (column 15, lines 40-47.”

4. The Examiner respectfully disagrees with Applicant’s position. Amended Claim 1 recites, *inter alia*, “a writing device which determines whether or not writing [information] is permitted based on the electronic tag information read by the electronic tag reader, and which writes [information] into the electronic tag when it is determined that the writing of the image is permitted.”

5. Lane et al. specifically disclose, “**The controller 4A may then access the security circuit 4F to authenticate the identity of the reader 10 and to determine if the reader 10 is authorized to request information from, or write information into, or otherwise direct the operation of the RFID tag 2**” (see Lane et al., column 15, lines 40-44) (emphasis added by Examiner). Lane et al. reader 10 in combination with the controller 4A satisfy the claimed “a writing device which determines whether or not writing [information] is permitted based on the electronic tag information read by the electronic tag reader, and which writes [information] into the electronic tag when it is determined that the writing of the image is permitted.” Therefore, the rejection will be maintained.

**With respect to amended Claim 4 and new Claim 11**

6. Applicant draws the conclusion, “It is respectfully submitted that neither Boles nor Lane et al. discloses or suggest this structure and method of amended independent claim 4 and new independent claim 11.” However, Applicant has provided no basis to support the conclusion. Therefore, the rejection will be maintained.

**With respect to amended Claim 5 and new Claim 12**

7. Applicant's arguments with respect to these claims have been considered but are moot in view of the new claim objections.

***Election/Restrictions***

8. Newly amended Claim 5 and newly submitted Claim 12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant's application shows at least two patentably distinct species under same genus. The

first species (embodiment) is directed to the camera, db management server (2), and db (3) portion of the system (see figure 1). The second species (embodiment) is directed to the tag reader/writer (6) and processing unit (7) portion of the system (see figure 1). Figures 2, 3, 6 – 8 are directed to the first species; while figures 4 and 9 are directed towards the second species. The original claim set (Claims 1-9) had claims directed towards an image pickup apparatus (Claims 1 – 4), an electronic tag reading apparatus (Claims 5 – 7), and a computer program product (Claims 8 and 9). Claims 1 – 4, 8, and 9 were clearly directed towards the first species and Claims 5 – 7 appeared to be generic to both species. Since the majority of claims were directed towards the first species, Applicant inherently elected the first species. The Examiner based the rejections in the Non-Final Rejection (mailed May 29, 2008) on Applicant's election. However, in the latest amendment (filed October 31, 2008), Claims 1, 3, 4, 10, and 11 continue to be directed towards the first species, while Claims 5 and 12 have been narrowed to the second species.

9. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **Claims 5 and 12** are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 4 and 11** are rejected under 35 U.S.C. 102(e) as being anticipated by Boles (US 2005/0103840 A1).

The Examiner notes that **Claims 4 and 11** are corresponding apparatus and method claims, respectively. For the sake of brevity, **Claims 4 and 11** will be rejected together using the claim language of **Claim 4**.

12. For **Claims 4 and 11**, Boles discloses, as shown in figures 1, 2, and 4 and as stated in paragraphs 34 – 37, 40, 42, and 44, a digital camera (computer 1) comprising:

an image capture device (11) which captures an image of an article (stone 12 or valuable 4);

an electronic tag reader (6) which reads, using a wireless transmission (reader/writer 6 is connected to the tag 7 via inductive coupling; see Boles paragraph 35), electronic tag information from an electronic tag (7), which is attached to the article (see Boles paragraph 42), when the image capture device captures the image of the article (see Boles paragraph 42); and

a writing device (6) which writes, using a wireless transmission (reader/writer 6 is connected to the tag 7 via inductive coupling; see Boles paragraph 35), the image of the article captured by the image capture device into the electronic tag based on the electronic tag information read by the electronic tag reader (6); and

a storing unit which stores into a database the image of the article (12 or V) written by the writing device into the electronic tag, in association with the electronic tag information read by the electronic tag reader (See paragraph 44. Boles states, “A communications link 5 links the

computer with its hard drive to an archive retrieval system 140 (e.g. a server) which hosts an image and information database 110 ... this database includes fields for the identifier (# symbol 1 to # symbol n), images (I1, I2. . . In) and transactions (T1, T2 . . . Tn) such that inputting the identifier of a gem stone or other valuable enables the corresponding sets of images and transactions to be retrieved by computer 1.”).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boles (US 2005/0103840 A1) in view of Lane et al.

15. For **Claim 1**, Boles discloses, as shown in figures 1 and 2 and as stated in paragraphs 34 – 37, 40, and 42, a digital camera (6, 1, 3, 2 and 11) comprising:

an image capture device (SEM 11) which captures an image of an article (stone 12 or valuable V) in response to a shutter operation (Boles discloses that the image capture device is a scanning electron microscope 11 that captures images; see paragraph 34. Any device that captures images inherently comprises captures those images in response to some shutter operation, including mechanical shutter means and/or electronic shutter means);

a display device (3) which displays the image of the article (stone 12 or valuable V) captured by the image capture device (see Boles, paragraph 34);

an electronic tag reader (6) which reads, using a wireless transmission (reader/writer 6 is connected to the tag 7 via inductive coupling; see Boles paragraph 35), electronic tag information from an electronic tag (7), which is attached to the article (see Boles paragraph 42), when the image capture device captures the image of the article (see Boles paragraph 42); and a writing device (6) which determines, when the image of the article is captured by the image capture device (11), which causes the electronic tag reader to read electronic tag information and writes the image of the article captured by the image capture device into the electronic tag (See paragraphs 34 – 36. Boles states, “The resulting digitized images are output to an inductive writer 6 which is arranged to store the images in a memory 8 of a miniature RFID ... tag 7.”).

However, Boles does not disclose wherein the writing device which determines whether or not writing information is permitted based on the electronic tag information read by the electronic tag reader, and which writes information into the electronic tag when it is determined that the writing of the image is permitted.

On the other hand, Lane et al. also disclose an apparatus for reading/writing from/to an electronic tag attached to an article. More specifically, Lane et al. show, in figure 1, a system comprising a computer (40), a database (12), an RFID tag (4), and an RFID reader (10). Lane et al. show, in figure 2, details of the RFID tag (4). Finally, in figures 3, 7, and 8, Lane et al. show granting reading/writing permission to the RRID reader (10) to read/write from/to the RFID tag (4). In this regard, Lane et al. specifically disclose, “The controller 4A may then access the security circuit 4F to authenticate the identity of the reader 10 and to determine if the reader 10 is authorized to request information from, or write information into, or otherwise direct the

operation of the RFID tag 2” (see Lane et al., column 15, lines 40-44). Lane et al. reader (10) in combination with the controller (4A) satisfy the claimed “a writing device which determines whether or not writing [information] is permitted based on the electronic tag information read by the electronic tag reader, and which writes [information] into the electronic tag when it is determined that the writing of the image is permitted.” In other words, Lane et al. provide the advantage that data regarding an article that the electronic tag is attached to is accurate.

Thus, the Examiner submits at the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included a decision unit which determines whether a writing of *data* is permitted, and wherein the writing device writes the *data* into the electronic tag when the decision unit determines that a writing of the *data* is permitted, as taught by Lane et al., in the image pickup apparatus disclosed by Boles.

16. As for **Claim 3**, Lane et al. further teach, as shown in figures 7 and 8, a communication interface (20), wherein the writing device (10) transmit the electronic tag information read by the electronic tag reader to a server (22) via the communications interface (20) and writes [information] into the electronic tag if a write permission is received from the server (also see column 21, line 50 – column 22, line 5).

*Allowable Subject Matter*

17. **Claim 10** is allowed.

***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Ometz can be reached on 571.272.7593. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Justin P. Misleh/  
Primary Examiner  
Group Art Unit 2622  
December 17, 2008**